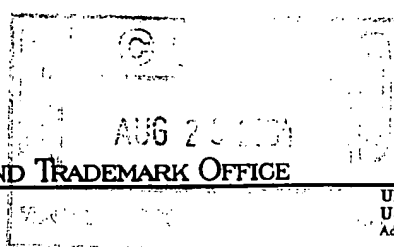




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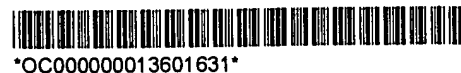


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APPLICATION NUMBER	FILING OR 371(c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/827,301	04/20/2004	Michael B. Zemel	31894-202099

CONFIRMATION NO. 2573

26694
VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998



OC000000013601631

Date Mailed: 08/20/2004

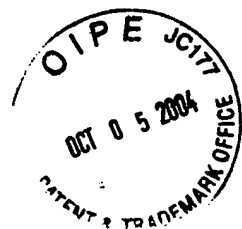
RESPONSE TO REQUEST FOR CORRECTED FILING RECEIPT

Claims, Fees, and Inventors

In response to your request for a corrected Filing Receipt, the Office is unable to comply with the request because:

- ☐ The total number of claims appearing on the Filing Receipt does not include multiple dependent claims. The total fee appearing on the Filing Receipt includes the cost of multiple dependent claims that were present at the time the application was filed.
- ☐ The filing fee is correct. It may include additional claims fees and/or the surcharge under 37 CFR 1.16 (e) for filing an oath/declaration or basic filing fee after the application filing date; or it may not reflect fees refunded to the applicant that were paid by mistake.
- ☐ The number of claims reflected on the filing receipt is correct. Upon review of the claims, it was found that there was a miscalculation by the applicant. This may be due to improperly presented multiple dependent claims, typographical error, misnumbering of the claims, or other oversight. An amendment may be necessary to correct the problem.
- ☐ The filing fee reflected on the filing receipt is correct. Applicant may have miscalculated the fees due.
- ☐ Applicant calculated fees as other than small entity; however, applicant asserted small entity status in the application. Therefore, fees were applied as small entity and the remainder was refunded to the applicant.
- ☐ The difference between the fees paid and the fees due was refunded to the applicant and will not be shown on the filing receipt.
- ☐ The inventor information may be truncated if the family name consists of more than 50 characters (letters and spaces combined) and if the given name consists of more than 50 characters (letters and spaces combined).

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- ☐ The inventor's residence allows for up to 40 characters (letters and spaces combined).
- ☐ The inventor's residence will only include the city and state for U.S. residences or city and country for residences outside the U.S. (See MPEP 605.02).
- ☒ A petition to correct the inventorship is needed to make this change. See 37 CFR 1.48. For non-provisional applications, the petition should be directed to the Director of the examining group assigned to your application.
- ☒ Changes made after submission of an executed declaration to the inventor information other than correction of typographical errors must be submitted in the form of a substitute declaration. Change of inventorship requires a petition under 37 CFR 1.48.
- ☐ The number of drawings shown on the filing receipt reflects the number of drawing sheets submitted and is not necessarily equal to the number of figures submitted.
- ☐ The correspondence address was captured as directed by applicant on filing. If you wish correspondence to be directed otherwise, please submit a request for a change of address.
- ☐ The docket number allows a maximum of 25 characters.
- ☐ The person signing on behalf of the deceased inventor is reflected on the Filing Receipt as the legal representative.
- ☐ The filing date of a parent application cannot be changed by this request. A petition to correct the filing date in the parent application is required.



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Initial Patent Examination Division (703) 308-1202

PART 1 - ATTORNEY/APPLICANT COPY



IFU

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Michael B. ZEMEL et al.

Appl. No.: 10/827,301

Confirmation No.: 2573

Filed: April 20, 2004

For: MATERIALS AND METHODS FOR
REGULATING BODY WEIGHT IN
NON-HUMAN ANIMALS

Art Unit: 1617

Examiner: *Unassigned*

Atty. Docket No.: 31894-202099

Customer No.

26694

PATENT TRADEMARK OFFICE

Response to Requirement for Petition to Correct Filing Receipt

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

An Office Response to Applicant's request for a corrected filing receipt was mailed on August 20, 2004 requiring a petition under 37 C.F.R. 1.48 to remove one of the listed inventors, because as set forth in the Office Response, "[c]hanges made after submission of an executed declaration to the inventor information other than correction of typographical error must be submitted in the form of a substitute declaration... [and c]hange of inventorship requires a petition under 37 C.F.R. 1.48."

Applicants respectfully submit that a petition is not required in the above-reference case because although Dr. Paul C. Carney was listed as inventor in the parent application, U.S.S.N. 10/066,057 ("057"), Dr. Carney was not listed as inventor in the originally filed documents for this application, and is not an inventor.

The above-referenced application was filed on April 20, 2004 as a continuation application of the '057 application. A declaration from the parent case, the '057 application, was submitted at the time of filing this continuation application. The declaration from the parent case does list Paula C.

Zemel (Dr. Carney's former name) as an inventor. However, it is clear from the remaining documentation submitted at the time of filing that Dr. Carney is not a named inventor in this case and that only Dr. Michael Zemel and Dr. Hang Shi are inventors. For example, both the application cover page of the specification and the application data sheet clearly indicate that there are only two inventors in this case, Michael Zemel and Hang Shi.

According to MPEP 602.05(a), if an inventor named in a prior application is not an inventor in a continuation or divisional application, the application may be filed with a copy of an oath or declaration from a prior application with a statement that the inventive entity is different, in that an inventor has been deleted. In this case, the documentation constitutes a statement that Dr. Carney is not a named inventor and the inventive entity consists only of Dr. Michael Zemel and Dr. Hang Shi.

In particular, according to 37 C.F.R. 1.76(d)(4) (MPEP 601.05), the inventor information should have been obtained from the application data sheet. Specifically, section 4 states:

The Office will initially capture bibliographic information from the application data sheet (notwithstanding whether an oath or declaration governs the information). Thus, the Office shall generally not look to an oath or declaration under § 1.63 to see if the bibliographic information contained therein is consistent with the bibliographic information captured from an application data sheet (whether the oath or declaration is submitted prior to or subsequent to the application data sheet).

However, in this case, the Filing Receipt mailed June 29, 2004, listed Dr. Paula C. Zemel (Dr. Carney's former name) as inventor. On July 20, 2004, Applicants submitted a request for corrected filing receipt, requesting (1) a correction to Dr. Hang Shi's address and (2) the removal of "Paula C. Zemel" from the filing receipt. In addition, the Applicants submitted a new declaration signed only by Dr. Michael Zemel and Dr. Hang Shi.

On August 20, 2004, the Office mailed a corrected filing receipt correcting Dr. Hang Shi's address, but not removing the name "Paula C. Zemel", and issued an Office Response to Request for Corrected Filing Receipt requiring a petition under 37 CFR 1.48 to change inventionship.

Applicants Zemel et al.,
Appl. No. 10/827,301

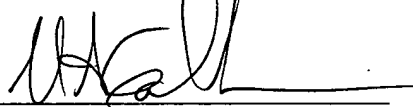
Applicants respectfully submit that as indicated in the record of the originally filed documents that the inventive entity for this application at time of filing includes only Dr. Michael Zemel and Dr. Hang Shi and that Dr. Paula Carney is not a named inventor. Therefore, there is no need for a Petition as requested in the August 20, 2004 Office Response. Applicants request that the Office withdraw the requirement for a petition for the above-referenced reasons and correct the Filing Receipt by removing the name "Paula C. Zemel" from the inventive entity.

In the alternative, if this request is not granted, applicants request the office to consider this response as a petition to take the necessary action so that Dr. Carney is not a named inventor.

No fee is due. If any fee is due, please charge to deposit account no. 22-0261.

Date: 10/5/04

Respectfully submitted,



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Dc2/584114

121239

Venable Filing Number

OCT 05 2004



Attorney/L: MAG/mg

PTO Due Date:

Date Filed: July 22, 2004

TM Official Gazette Date:

Atty. Docket No: 31894-202099

Re: Michael B. ZEMEL et al.

Application No: 10/827,301

Patent No.:

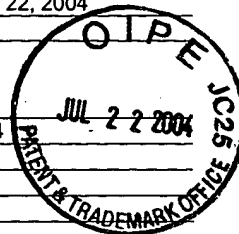
Trademark:

Opposition/Cancellation No:

Filing Date: April 20, 2004

Issue Date:

Trademark Reg. No:



The following items were received from Venable, Washington, D.C., by the U.S. Patent & Trademark Office:

U.S. PTO FEES ENCLOSED

- ☐ Missing Parts Transmittal Letter
☐ Utility Transmittal Letter
☐ New U.S. Provisional Application (pages of specification/claims/abstract)
☐ Formal Drawings (sheets Figs.)
☒ **Submission of Supplemental Declaration and executed Supplemental Declaration**
☐ U.S. National Stage Application of PCT Application
☐ Translation of International Application
☐ New U.S. TM Application (specimens)
☐ Rule 53(d) Continued Prosecution Application
☐ Substitute Specification
☐ Rule 53(b) Continuation or Divisional Application (*attach copy of specification, claims, drawings & declaration*)
☐ Priority Document-Cert. Copy of Appln.#.; Country;
☐ Date Filed:
☐ Request for Continued Examination (RCE) under 37 CFR 1.114
☐ Request for Reconsideration
☒ **Supplemental Application Data Sheet**
☐ Assignment w/Cover Sheet
☐ IDS w/ PTO SB/08 a/k/a PTO Form-1449 (references)
☐ Response
☐ Amendment/☐ Preliminary Amendment
☐ Petition/Request for Extension of Time (one mo. ext.)
☐ Notice of Appeal
☐ Appeal Brief (*in triplicate*)
☐ Reply Brief (*in triplicate*)/ ☐ Request for Oral Hearing
☐ Confirmation of Hearing Petition
☐ Issue Fee Transmittal
☐ Certificate of Correction
☐ Maintenance Fee Transmittal
☐ Power of Attorney
☐ Response to Notice to File Missing Parts
☐ Response to Notice to File Missing Requirements
☐ Response to Restriction Requirement
☐ Petition to Revive
☐ Sequence Listing – CDR Enclosed? ☐ Yes ☐ No
☐ Status Inquiry
☐ Request for Non-Publication
☐ Request to Rescind Non-Publication Request
☐ Terminal Disclaimer
☐ TM Statement of Use
☐ Extension of Time (mo. ext.)
☐ Declaration Under 8
☐ Declaration Under 8 and 15
☐ TM Renewal Application
☐ Notice of Opposition (*Please list all documents in Other section*)
☐ Amendment to Alleged Use

☒ **Request for Corrected Filing Receipt (along with a marked-up copy of the Filing Receipt)**
☐
☐

- _____ Filing Fee
 _____ Surcharge Fee
 _____ Additional Claim Fee
 _____ Recordation/Indexing Fee
 _____ IDS Fee
 _____ Extension Fee
 _____ Notice of Appeal Fee
 _____ Brief on Appeal Fee
 _____ Oral Hearing Request Fee
 _____ Petition Fee
 _____ Issue Fee
 _____ Publication Fee
 _____ Maintenance Fee
 _____ TM Statement of Use
 _____ 8 Affidavit Fee
 _____ 8 and 15 Affidavit
 _____ TM Renewal Application Fee
 _____ Notice of Opposition Fee
 _____ TM Extension of Time Fee

\$0.00 Total Fees Paid

Check Number

Attached

Charge Deposit Account No. 22-0261*

☐ Yes ☒ No

*If the Deposit Account was used, was a copy of this form sent to Accounting?

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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Michael B. ZEMEL et al.

Appl. No.: 10/827,301

Confirmation No.: 2573

Filed: April 20, 2004

For: Materials and Methods for Regulating
Body Weight in Non-Human Animals

Art Unit: 1617

Examiner: Not Yet Assigned

Atty. Docket No. 31894-202099

Customer No. 26694

SUBMISSION OF SUPPLEMENTAL DECLARATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

Submitted herewith is a Supplemental Declaration executed by the inventors which correctly lists the current address of inventor Hang SHI. Please correct the U.S. Patent and Trademark Office records accordingly.

Date: 7/20/2004

Respectfully submitted,

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RK/mg
Enclosure
PC Docs No. 564445